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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/689,568	10/20/2003	Denwood F. Ross III	27109-32	8437

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EXAMINER
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SHIH, THEODORE C

ART UNIT	PAPER NUMBER
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3735

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/689,568	<b>Applicant(s)</b> ROSS, DENWOOD	
	<b>Examiner</b> Theodore C. Shih	<b>Art Unit</b> 3735	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 21 is/are rejected.
- 7) ☒ Claim(s) 17-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "second sealing member" of claim 9 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

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2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Objections***

3. Claims 5, 6, 9, 11, 12, 15, and 16 are objected to because of the following informalities: In Claim 5, lines 2 and 3; Claim 6, line 2; Claim 9, line 2; Claim 11, line 3, and Claim 12, lines 3 and 5, --element-- should be inserted following "lens". Appropriate correction is required.

4. Claims 11 and 12 are objected to because of the following informalities: In Claim 11, line 2 and Claim 12, line 5 "element" should be deleted. Appropriate correction is required.

5. Claim 15 is objected to because of the following informalities: In Claim 15, line 2 "element" should be inserted following "lens" (first occurrence). Appropriate correction is required.

6. Claim 16 is objected to because of the following informalities: In Claim 16, line 6, --of said image forming lens-- should be inserted following "surface". Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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8. Claims 5, 6, and 9-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claims 5, 6, 9, and 12, the claim language is indefinite as to how many image forming lens elements there are. The claims appear to definitively state that there is only one lens element; however, the antecedent recites that there can be more than one image forming lens.

Regarding Claim 10, Claim 10 recites the limitation "said housing" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Regarding Claim 13, the pronoun "it" renders the claim indefinite. One cannot be certain what "it" is intended to refer to.

Regarding Claim 15 at line 2, the claim language renders the claim indefinite because the claims (13-15) do not recite that there may be more than one image forming lens prior to this recitation.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-8, 10-16, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Volk'222 (US Patent 5,479,222).

Regarding Claims 1 and 16, Volk'222 teaches an ophthalmoscopy lens system including a plastic adapter lens (col. 7, lines 15-20); an adapter lens that is a contact lens (col. 8, lines 8-12) having a posterior lens surface with a concave shape (col. 8, line 40); and indirect ophthalmoscopy lens (image forming lens element) (col. 8, line 14) having an anterior and posterior surface where the anterior surface has a corresponding shape to the anterior surface of the contact lens element (see element 86 and 72, Figure 4).

Regarding Claims 2, 11, and 12, Volk'222 teaches an ophthalmoscopy lens system including an adapter housing providing selective attachment (annular ring) having an outer diameter slightly larger than the inner diameter of the housing so as to maintain the contact lens element and image forming lens in a mating, optically-aligned relationship (See Figure 4) and forming a sealed fluid air space between the adapter lens and interior lens (col. 6, lines 49-51).

Regarding Claims 3, 5, 7, 8 and 15, Volk'222 teaches an ophthalmoscopy lens system including adapter lens housing and ophthalmoscopy lens housing (col. 6, lines 39-40) with a compressible and resilient o-ring (sealingly mounted) used to frictionally engage the inner surface of the housing (sealing member) (col. 6, lines 43-45).

Regarding Claim 4, Volk'222 teaches an ophthalmoscopy lens system including screw threads used to attach (threadingly mounted) the adapter lens housing (col. 6, lines 47-48).

Regarding Claim 6, Volk'222 teaches an ophthalmoscopy lens system including lens positioned within a conventional retainer housing and may be fixed in position by

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means of a lens retaining ring screwed into place after insertion of the lens into the housing (col. 6, lines 31-35).

Regarding Claim 12, Volk'222 teaches an ophthalmoscopy lens system including an adapter housing providing selective attachment (annular ring) having an outer diameter slightly larger than the inner diameter of the housing so as to maintain the contact lens element and image forming lens in a mating, optically-aligned relationship (See Figure 4).

Regarding Claims 13 and 14, Volk'222 teaches an ophthalmoscopy lens system including a first lens element made of plastic (col. 7, line 17) and second lens element made of glass (col. 10, line 14) (See element 85 and 86 respectively, Figure 4) in a watertight configuration (col. 6, line 50).

Regarding Claim 21, teaches an ophthalmoscopy lens system including a concave anterior surface of the contact lens (see element 72, Figure 4) and a biconvex image forming lens (see element 86, Figure 4).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Volk'222. Volk'222 teaches an ophthalmoscopy lens system including a plastic adapter lens (col. 7, lines 15-20); an adapter lens that is a contact lens (col. 8, lines 8-12) having a

posterior lens surface with a concave shape (col. 8, line 40); and indirect ophthalmoscopy lens (image forming lens element) (col. 8, line 14) having an anterior and posterior surface where the anterior surface has a corresponding shape to the anterior surface of the contact lens element (see element 86 and 72, Figure 4); a sealed air space between the adapter lens and interior lens (col. 6, lines 49-51); adapter lens housing and ophthalmoscopy lens housing (col. 6, lines 39-40) with a compressible and resilient o-ring (sealingly mounted) used to frictionally engage the inner surface of the housing (sealing member) (col. 6, lines 43-45); screw threads used to attach (threadingly mounted) the adapter lens housing (col. 6, lines 47-48); lens positioned within a conventional retainer housing and may be fixed in position by means of a lens retaining ring screwed into place after insertion of the lens into the housing (col. 6, lines 31-35); adapter housing providing selective attachment (annular ring) having an outer diameter slightly larger than the inner diameter of the housing so as to maintain the contact lens element and image forming lens in a mating, optically-aligned relationship (See Figure 4); a first lens element made of plastic (col. 7, line 17) and second lens element made of glass (col. 10, line 14) (See element 85 and 86 respectively, Figure 4) in a watertight configuration (col. 6, line 50); a concave anterior surface of the contact lens (see element 72, Figure 4) and a biconvex image forming lens (see element 86, Figure 4).

Regarding Claim 9, Volk'222 teaches resilient fingers (col. 6, lines 43-46) but does not expressly teach a second sealing member. Resilient fingers (or finger washers) are an alternate equivalent to sealing members. It would have been obvious



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at the time the invention was made to a person having ordinary skill in the art to substitute resilient fingers for sealing members in a lens system similar to that of Volk'222 since it has generally been held to be within the skill level of the art to substitute alternate equivalent expedients.

***Allowable Subject Matter***

13. Claims 17-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

14. The following is a statement of reasons for the indication of allowable subject matter: Volk'222 teaches an ophthalmoscopy lens system including a plastic adapter lens (col. 7, lines 15-20); an adapter lens that is a contact lens (col. 8, lines 8-12) having a posterior lens surface with a concave shape (col. 8, line 40); and indirect ophthalmoscopy lens (image forming lens element) (col. 8, line 14) having an anterior and posterior surface where the anterior surface has a corresponding shape to the anterior surface of the contact lens element (see element 86 and 72, Figure 4); a sealed air space between the adapter lens and interior lens (col. 6, lines 49-51); adapter lens housing and ophthalmoscopy lens housing (col. 6, lines 39-40) with a compressible and resilient o-ring (sealingly mounted) used to frictionally engage the inner surface of the housing (sealing member) (col. 6, lines 43-45); screw threads used to attach (threadingly mounted) the adapter lens housing (col. 6, lines 47-48); lens positioned within a conventional retainer housing and may be fixed in position by means of a lens retaining ring screwed into place after insertion of the lens into the housing (col. 6, lines

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31-35); adapter housing providing selective attachment (annular ring) having an outer diameter slightly larger than the inner diameter of the housing so as to maintain the contact lens element and image forming lens in a mating, optically-aligned relationship (See Figure 4); a first lens element made of plastic (col. 7, line 17) and second lens element made of glass (col. 10, line 14) (See element 85 and 86 respectively, Figure 4) in a watertight configuration (col. 6, line 50); a concave anterior surface of the contact lens (see element 72, Figure 4) and a biconvex image forming lens (see element 86, Figure 4). However, none of the prior art teaches or suggests, either alone or in combination an ophthalmoscopy lens system including a vacuum between the contact lens element and image forming lens; and a fluid layer between the contact lens element and image forming lens.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore C. Shih whose telephone number is (571) 272-7234. The examiner can normally be reached on 8:30-5:00 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Marmor II can be reached on (571) 272-4730. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TS.

5/30/06



Charles A. Marmor II  
STE Art Unit 3735